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IN THE

Supreme Court of the United States

OCTOBER TERM, 1957.

No. 508

S. H. KRESS & COMPANY,
Petitioner,

vs.

ELIE P. AGHNIDES AND CHASE BRASS & COPPER CO., INC.,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT.

Your Petitioner, S. H. Kress & Company, prays that a writ of certiorari issue to review the judgment of the Court of Appeals for the Fourth Circuit, entered in the above entitled case on May 17, 1957.

OPINIONS BELOW

The Opinion of the District Court (1 App. 93-104)* is reported at 140 F. Supp. 582. The Opinion of the Court of Appeals of the Fourth Circuit, reported at ..... F. 2d ....., is printed in Appendix A hereto, *infra*, pages i to xiv. The Court of Appeals' Supplementary Opinion on Motions for

* "1 App. . . ." and "2 App. . . ." refer respectively to the portion of the Trial Record printed in Volume 1 and Volume 2 of Appellant's (Kress') Appendix before the Court of Appeals of the Fourth Circuit.

Rehearing is printed in Appendix A, *infra*, pages xv to xviii.

The prior Opinion of the Court of Appeals of the Seventh Circuit, with which the Opinion of the Court of Appeals of the Fourth Circuit is in direct conflict, is *Aghnides* v. *Goodrie et al.*, 210 F. 2d 859, certiorari denied 348 U. S. 826[1], and is printed in Appendix B hereto, *infra*, pages xix to xxv.

The validity of the patent here involved,[2] was adjudicated in an uncontested case in the District Court for the Middle District of North Carolina, Greensboro Division, in the Fourth Circuit, in *Aghnides* v. *The Meyer's Company*, 117 F. Supp. 839, 99 U. S. P. Q. 488, and 99 U. S. P. Q. 335. No appeal was taken.[1]

The validity of the subject patent was also adjudicated by summary judgment in the District Court for the Northern District of Illinois in *Aghnides* v. *Holden et al.*, 104 U. S. P. Q. 168; but the decision of the District Court was reversed by the Court of Appeals for the Seventh Circuit, 226 F. 2d 949 (printed in Appendix C hereto, *infra*, pages xxvi to xxx), on the basis that Summary Judgment should not have been granted, and the case was remanded and now awaits trial.

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1. Based in part upon the uncontested District Court Opinion of validity, and the Seventh Circuit's Opinion of invalidity, Aghnides petitioned this Court for review, but, rightfully, this Court denied that Petition.. 348 U. S. 826.

2. U. S. Patent No. 2,210,846, issued to E. P. Aghnides and entitled "Fluid Mixing Device".

JURISDICTION

The Judgment of the Court of Appeals for the Fourth Circuit was entered on May 17, 1957. Kress' timely Motion for Rehearing was denied in a Supplementary Opinion dated July 9, 1957.

This Court's jurisdiction is invoked under Title 28 U. S. C. § 1254(1). Jurisdiction is also based upon a direct conflict in the Opinions of the Courts of Appeals of the Fourth Circuit and the Seventh Circuit. *Universal Oil Co.* v. *Globe Oil Co.*, 322 U. S. 471, 473; 64 S. Ct. 1110, 1111.

Jurisdiction is also based upon the fact that there is pending substantial litigation in the Second Circuit[3] and Seventh Circuit[4] involving the Aghnides patent 2,210,846, which is the subject of this Petition; and in the interest of uniformity it is submitted that the conflict of opinions should be resolved.

Jurisdiction is also based upon the fact that one issue herein involves the International Patent Convention, an international "treaty" to which the United States has adhered since 1887. The issue presented is a substantial one, is one of first impression before this Court, and is of great public importance. It is important that this Court express itself on this substantial issue, since it involves a Treaty.[5]

3(a). *Marshall Metal Products* v. *Aghnides*, Civil Action 85-272, Filed June 3, 1953 in the District Court for Southern District of New York (2 App. 141).

(b). *Melard Mfg. Corp.* v. *Aghnides*, Civil Action 95-355, Filed September 16, 1954 in the District Court for Southern District of New York (2 App. 144).

4(a). *Aghnides* v. *Holden et al.*, Civil Action 50 C 1022, Filed July 19, 1950 in the District Court for Northern Illinois, Eastern Division (2 App. 137).

(b). *Melard Mfg. Corp.* v. *Chase Brass & Copper Co., Inc., et al.*, Civil Action 55 C 84, Filed Jan. 18, 1955, in the District Court for Northern Illinois, Eastern Division (2 App. 145 A).

5. United States Constitution—Article III, Section 2.

QUESTIONS PRESENTED

I. Where a foreign inventor, seeking the special privileges afforded him by the International Patent Convention, first applies for a patent in Belgium and thereafter files in both the United States and Canada other applications for patent, securing in both United States and Canada *identical* patent claims—monopolies—predicated upon *asserting* in the United States, and *repudiating* in Canada, continuity with the same Belgian application, then do the opposite positions of both *asserting and repudiating* continuity with the same Belgian application constitute a background of fraud or inequitable conduct which renders the United States patent invalid or unenforceable in equity?

In short—may an inventor misuse the International Patent Convention to remove a bar in order to obtain patent claims in the United States, and make a directly contradictatory sworn statement in order to obtain the identical patent claims in another country, both adherents to the International Patent Convention?

II. The Court of Appeals for the Fourth Circuit found patent 2,210,846 to be valid over the prior British patent to Felten.

The Court of Appeals for the Seventh Circuit found patent 2,210,846 to be invalid in view of the prior British patent to Felten.

(A) The broad question, raised by the conflict, is—Is the patent valid or invalid?

(B) A narrower collateral question presented is—Where Aghnides and the Patent Office both agreed during prosecution of the application for patent that the claims of patent 2,210,846 read on the device shown in Figure 8 of the patent, and where Aghnides now ad-

mits that Figure 8 is the same as the Felten prior art patent, then is not patent 2,210,846 invalid as a matter of law?

STATUTES AND TREATIES INVOLVED

The Statutes herein involved are the Patent Statutes, and in particular, R. S. 4886 and R. S. 4887, 35 U. S. C., § 102, printed in Appendix D hereto, *infra*, page xxxi.

The Treaty involved is the International Patent Convention, 53 Statutes 1748. Pertinent portions of the Treaty are printed in Appendix D hereto, *infra*, pages xxxii to xxxvii.

STATEMENT OF FACTS

I. The facts relevant to Question I are:

On December 8, 1934, Aghnides, a citizen of Greece (2 App. 30), filed application for patent in Belgium. The Belgian patent issued on January 31, 1935 (2 App. 11-18). Another Aghnides patent corresponding to the Belgian application issued in Great Britain on July 6, 1937 (2 App. 218-220).

On December 4, 1935, claiming under the International Patent Convention, Aghnides filed a first application for patent in the United States (2 App. 19-31).

The 1935 U. S. application corresponding to the Belgian application did not issue as a patent (2 App. 47). While the 1935 U. S. application was pending, Aghnides filed a second, new and different, U. S. patent application on December 31, 1937 (2 App. 49-60), resulting in the patent in suit, No. 2,210,846 (2 App. 1-5).

During the prosecution of the 1937 U. S. application, the issued Aghnides British patent was cited by the Patent Examiner as prior art (2 App. 71-72). The British patent would have been insurmountable opposition to the issuance of a patent. To avoid this basis of opposition, Aghnides asserted that the second filed 1937 U. S. application was for the same invention as disclosed earlier in Belgium (2 App. 58-59, 72-73), and hence was entitled to the benefits of the International Patent Convention, and to an effective filing date of December 8, 1934. (Since the Belgian filing date was prior to the filing date for the British patent, the assertion of continuity and similarity between the Belgian and the second filed U. S. applications was effective to obviate the Patent Examiner's rejection.) Only said representation and assertion to the U. S. Patent Office (of continuity and similarity between the Belgian and the second filed U. S. applications) induced the U. S. Patent Office to no

longer consider the Aghnides British patent as a prior art reference.

On August 6, 1940, patent 2,210,846 issued and bore on its face (2 App. 3), the assertion of continuity between it and the 1934 Belgian application.[6]

On November 15, 1939, nearly five years after the filing date of the 1934 Belgian application, Aghnides filed an application for patent in Canada (2 App. 323-335). Aghnides asserted in said application five claims identical with the five claims in the issued U. S. patent 2,210,846 (2 App. 345). The Canadian Patent Office, like the U. S. Patent Office, cited the 1937 British patent as a prior art reference (2 App. 359), and also inquired as to the status of the Belgian application upon which, Canada noted, the U. S. patent 2,210,846 based convention priority (2 App. 359).

Aghnides, in his reply to the Canadian Patent Office, on the question of Convention priority, *repudiated* any similarity between the U. S. patent 2,210,846 and the 1934 Belgian application, stating (2 App. 361):

> "There is an important fact to remember, however; the said Belgian 1934 application[7a] *did not* disclose fully the bubbly-stream principle disclosed in Holland, Sweden, the United States patent No. 2,210,846, the instant Canadian case and British Specification No. 625,084. (Emphasis is Aghnides'.)

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6. Incidentally, the Aghnides U. S. patent 2,316,832 which was also in issue in the trial of this case, also bears on its face an assertion of continuity between it and the 1934 Belgian application, as Aghnides asserted such continuity under the International Patent Convention before the U. S. Patent Office. The Trial Record conclusively shows that no such continuity exists, and that the reference in patent 2,316,832 to the 1934 Belgian Convention application is erroneous.

7a. This is the patent application which is referred to in the U. S. oath (2 App. 58-59), and which was relied upon to claim Convention priority for the U. S. Patent 2,210,846.

"It is only in December 1937[7b] that the ways and means of making a bubbly-stream were disclosed when the United States text (application No. 182,884) was rewritten, although the Convention Belgian application did mention the emulsion of air in a water stream.

"Therefore, the priority claims in the present case are correct and support properly the instant disclosure: *it is the Belgian Convention which, in the United States patent No. 2,210,846 confuses the issue* because, actually said Belgian case does not teach the bubbly-stream as it is known to-day. (Emphasis ours.)

"The same remarks apply also to the British Specification No. 468,687 which was filed December 4th, 1935, prior to the first disclosure of the bubbly-stream in United States, December 1937."[7c]

II. The facts relevant to Question II are:

The Aghnides patent 2,210,846 is entitled "Fluid Mixing Device". It is described as a device "for intimately mixing gas with a liquid" (2 App. 3, Col. 1, Lines 1-2), and is now known as an "aerator" for use on an ordinary home faucet.

The Felten (British) patent of 1909 (2 App. 275-277), upon which the Court of Appeals of the Seventh Circuit relied in holding the Aghnides patent invalid, is entitled "Improvements in or relating to Mixing Devices". The Felten specification states (2 App. 275):

"This invention relates to a new mixing device chiefly intended for producing such mixtures from a gas or vapour-like substance and a liquid substance . . ."

A specific use of Felten's mixing device is shown in the

7b. This date is 3 years after the Convention date claimed and appearing on Patent 2,210,846.

7c. The import of this statement is directly contrary to what Aghnides told the U. S. Patent Office (2 App. 73) when it cited the Aghnides British patent 468,687 as a prior art-reference.

U. S. Fuss patent, 1,090,044 (2 App. 299-305) as being mounted at the discharge end of an ordinary home faucet. Tests of a Felten device before the Trial Court showed that it delivered a non-splash bubbly stream of air and water. (1 App. 145, 149).

Aghnides' patent discloses a number of alternate forms of his device (2 App. 1). During the prosecution of his application for patent in the U. S., he affirmatively asserted that claims, which are here in issue, read on the form of device shown in Figure 8 of the patent (2 App. 95). The Patent Office agreed (2 App. 104).

Aghnides now admits that Figure 8 is like Felten and thus is old in the prior art. However, Aghnides now asserts, and the Fourth Circuit Court of Appeals has so held, that Figure 8 is outside the scope of the claims of the patent which is here in issue.

This latter holding of the Court of Appeals of the Fourth Circuit is in direct conflict with the Opinion of the Court of Appeals for the Seventh Circuit[8].

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8. In *Aghnides* v. *Goodrie et al.*, 210 F. 2d 859, 863 (Appendix B, *infra*, pages xxiv to xxv), the Seventh Circuit stated:

"* * * Felten reads literally on the claims of Aghnides * * *

* * * * * *

The important thing is that each introduces a vapor, a gas, ozone or air, into moving water in order to mix the two substances. It seems to us utterly immaterial that Felten's apparatus may also be used as a vacuum pump; so indeed may one form of Aghnides. Element for element, the two are the same * * * We conclude then that the trial court rightfully found that Felten anticipated Aghnides and taught the latter all that he needed to know in order to build his mixer of gas and fluid, *i.e.*, air and water."

REASONS FOR GRANTING THE WRIT

I. The Issues Relating to Patent Misuse, or Fraud, Under the International Patent Convention Are Ones of First Impression and Are of Great Public Importance.

Aghnides' claimed dates of invention, for the same invention, in the U. S. and in Canada are wholly contradictory. The date claimed in the U. S. is expressly *repudiated* in Canada. Both positions cannot be correct.

The alternative defenses presented by Kress were that—

(1) Aghnides falsified to the U. S. Patent Office (to remove the 1937 British patent as a reference), and therefore the '846 patent was invalid, as it was procured by fraud. *Hazel-Atlas Glass Co.* v. *Hartford Empire Co.*, 322 U. S. 238, 250; 64 S. Ct. 997, 1003.

(2) The undisclosed fraud perpetrated on either the U. S. or Canada as to the identical claims here in controversy disentitles the patentee to any equitable relief. *Precision Instrument Mfg. Co.* v. *Automotive Maintenance Machinery Company*, 324 U. S. 806, 816; 65 S. Ct. 993. 998.

(3) The false pre-trial testimony[9], to "cover up" and hide the fact that the claimed date of invention in Canada conflicted with the claimed date of invention in the U. S., disentitles the patentee to equitable relief. *Keystone-Driller Co.* v. *General Excavator Co.*, 290 U. S. 240, 244, 54 S. Ct. 146, 147.

(4) The misuse of the International Patent Convention to claim one date of invention in the U. S. and to claim a different date of invention in Canada, for identical claims here in controversy, disentitles the patentee to equitable relief. *Precision Instrument Mfg. Co.*

9. At pre-trial deposition Aghnides testified (1 App. 301), that his Canadian patent was based on his Belgian patent, and was filed within the one year period following the filing of the Belgian application (as provided for by the International Convention). The Canadian application was actually filed nearly five years after the filing date of the Belgian application (2 App. 323), and its file wrapper expressly denies that the Canadian application is based on the Belgian patent (2 App. 361).

v. *Automotive Maintenance Machinery Company,* 324 U. S. 806, 65 S. Ct. 993.

In its Opinion (Appendix A, *infra,* page xiii) the Fourth Circuit decided that Aghnides told the truth to the U. S. Patent Office, and declined to find that Aghnides' representations in Canada, even if they were untrue, constituted misconduct—

> "* * * so closely related to the proceedings in this country and the issuance of the patent to him here as to invalidate the grant or to constitute such unclean hands as to disentitle him to the relief he asks in this case."

In so holding, the Fourth Circuit committed the following errors of law:

First. The facts show that Aghnides has admitted, in Canada (2 App. 361):

> "* * * the said Belgian 1934 application *did not* disclose fully the bubbly-stream principle disclosed in * * * the United States patent No. 2,210,846 * * *",
>
> and
>
> "It is only in December 1937 that the ways and means of making a bubbly stream were disclosed when the United States text (application No. 182,884) was rewritten * * *", and
>
> "* * * actually said Belgian case does not teach the bubbly-stream as it is known today."

Despite these clear and unequivocal admissions by Aghnides, the Fourth Circuit Court stated (Appendix A, *infra,* page xiii):

> "* * * From our own examination of the United States patent '846 and the Belgian patent, we think it unquestionably true that they are, as Aghnides told the United States Patent Office, the same invention."

The Fourth Circuit's failure to consider the conclusive admissions against interest made by the patentee in a

foreign patent corresponding to the one in suit, appears to be in direct conflict with the rule of law enunciated by the Second Circuit in the case of *Jungerson* v. *Baden et al.*, 2 Cir. 166 F. 2d 807, 809 (affirmed 335 U. S. 560, 69 S. Ct. 269—Supreme Court—1949).

In the *Jungerson case*, the inventor's appraisal of his own invention, as was found to be stated in his British patent, was held, by the Second Circuit Court of Appeals, to be a controlling admission which was binding upon the inventor's U. S. patent. The *Jungerson* case thus stands for the proposition of law that an inventor's appraisal of his own invention and of the prior art relating to it, as appears in his own foreign patents, constitutes a binding admission against interest.[10]

The failure by the Fourth Circuit in the instant case to consider Aghnides' statements in Canada to be binding admissions against interest thus appears to be in direct conflict with the Second Circuit on this point of law.

Second. (a) The question of withholding equitable relief—because of the patentee's misuse of the International Convention, or by reason of his perpetrating a fraud upon Canada, under the Convention, based on his U. S. '846 patent—is one of first impression before the U. S. Courts.

(b) The refusal by the Fourth Circuit to withhold equitable relief based on the patentee's misuse or fraud under the International Patent Convention, and the Fourth Circuit's holding that Aghnides' Canadian patent proceedings (involving the identical patent claims here in issue which were procured in the U. S. under the Convention) "would not be so closely related to * * * the issuance of the patent to him here", failed to take cognizance of the pertinent Supreme Court decisions respecting rights and obligations under treaties.

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10. Also see *Sarazin et al.* v. *Wright Aeronautical Corp.*, 54 F. Supp. 244, 251 (affirmed 162 F. 2d 960, 2 Cir.—1947), wherein the same rule of law was invoked.

The Supreme Court has stated with regard to "treaties", *United States* v. *Belmont*, 301 U. S. 324, 330, 57 S. Ct. 758, 761, that:

> "A treaty signifies 'a pact made between two or more independent nations, *with a view to the public welfare*'." (Emphasis ours.)

The Supreme Court has also stated in regard to "treaties", in the case of *The United States* v. *The Libelants and Claimants of The Schooner Amistad, etc.*, 40 U. S. 518, 595, 10 L. Ed. 826, 854, that:

> "* * * In the solemn treaties between nations it can never be presumed that either State intends to provide the means of perpetrating or protecting frauds; * * *"

In view of what the Supreme Court stated in the *Amistad* case, *supra*, it must be presumed that the United States did not intend, in its grant of the '846 patent, to provide a means for perpetrating a fraud on Canada. However, the record is clear that the claims in the Canadian patent were there entered and allowed primarily because they were identical with the ones that had been allowed in the United States Patent Office (2 App. 345-346).

While it is not incumbent upon the Canadian Patent Office to be bound by the acts of the United States Patent Office, it may be stated, as a matter of common knowledge, that in the actual practice of patent law the acts of the United States Patent Office are given great weight (almost full faith and credit) by the Canadian Patent Office. It will be seen from the nature of the amendment (2 App. 345-346) that Aghnides sought allowance of claims in the Canadian Patent Office solely on the basis that the United States Patent Office had previously allowed the same claims.

Later, in the prosecution of his patent in the Canadian Patent Office, Aghnides repudiated the convention date

claimed in the United States patent, and thereby perpetrated his fraud.

Briefly, the facts show that Aghnides, to avoid a statutory bar in the United States (against the application resulting in U. S. patent 2,210,846), claimed his date of invention as of December 8, 1934 (the Belgian application's filing date)—and, to avoid a statutory bar in Canada (based on the Belgian application's filing date), Aghnides claimed his date of invention as of December 31, 1937 (the filing date of the U. S. application resulting in U. S. patent 2,210,846).

The patent claims in both U. S. and Canada are *identical*. However, the dates of invention of said *identical* claims is *different*. And, in the U. S., the Belgian 1934 application is said to be for the *identical* invention as in the U. S. patent—while in Canada, the Belgian 1934 application is said to be for a *different* invention than in the U. S. and Canada.

For the purpose of getting patent claims in Canada, the U. S. patent claims (obtained from the U. S. only because *identity* was asserted between the U. S. application and the 1934 Belgian application) were inserted into the Canadian patent application; and, to avoid a statutory bar in Canada (based on issued patents resulting from the 1934 Belgian application), the Canadian claims (identical with the U. S. claims) were stated to be for a *different* invention than the 1934 Belgian application—with the explanation that:

> "* * * it is the Belgian Convention which, in the United States patent No. 2,210,846 confuses the issue * * *" (2 App. 361).

This juggling of dates and Convention priority by Aghnides was deliberate and with the intent to obtain patent monopolies for which there was no legal justification, morally or in fact.

Thus, it was not the sole issue in this case, whether or not Aghnides told the truth in the United States or in

Canada, and it was not an issue to determine which of the two patents was obtained by fraud. If either of the two patents was obtained by fraud, that is sufficient for this Court to take an interest in the matter and to make its determination thereon. For, as was stated by the Supreme Court in the *Amistad* case (40 U. S. 518, 594, 10 L. Ed. 826, 854) with regard to rights which were being asserted under the provisions of a treaty:

> "* * * What we proceed upon is this, that although public documents * * * certainly are to be deemed *prima facie* evidence of the facts which they purport to state, yet they are always open to be impugned for fraud; and *whether that fraud be in the original obtaining of these documents, or in the subsequent fraudulent and illegal use of them, when once it is satisfactorily established it overthrows all their sanctity*, and destroys them as proof. Fraud will vitiate any, even the most solemn transactions, and an asserted title to property, founded upon it, is utterly void." (Emphasis ours.)

Aghnides' purpose and scheme was to obtain patents in as many countries as possible. By reason of the evidence that has been presented, it is unquestionable that a portion of his scheme was unlawful—regardless whether the unlawful portion of the scheme occurred in the United States or in Canada—and the scheme also involved the steps of obtaining of the U. S. patent, relying on the International Convention so to do, and thereafter using that patent as the basis for obtaining the identical claims in the Canadian patent, and repudiating the very basis that procured the same claims in the United States. As the Supreme Court has pointed out in the case of *Steele et al.* v. *Bulova Watch Co., Inc.*, 344 U. S. 280, 287, 73 S. Ct. 252, 256:

> "* * * acts in themselves legal lose that character when they become part of an *unlawful* scheme * * * (Citing cases). In such a case it is not material that the source of the forbidden effects upon * * * commerce

arises in one phase or another of that program * * * (Citing cases)" (Emphasis ours).

In the *Steele* case, *supra*, the Supreme Court also stated (344 U. S. 280, 282, 73 St. Ct. 252, 254) that:

> "* * * Congress in prescribing standards of conduct for American citizens may project the impact of its laws beyond the territorial boundaries of the United States * * * (Citing cases)."

Certainly the Courts of the United States, in the exercise of their equity power, may require, of those who seek equity before them, a standard of conduct with respect to acts involving the subject matter before them, even if such acts occurred outside the territorial boundaries of the United States, of the type which would have been required of the same party had the acts taken place within the boundaries of the United States. *Steele et al.* v. *Bulova Watch Co., Inc., supra; Precision Instrument Mfg. Co.* v. *Automotive Maintenance Machinery Co., supra; Hazel-Atlas Glass Co.* v. *Hartford Empire Co., supra; Keystone-Driller Co.* v. *General Excavator Co., supra.*

The "public welfare" purposes with which treaties are endowed (as stated by the Supreme Court in the *Belmont* case, *supra*), morally requires each signatory nation of a treaty

> (1) to affirmatively support the treaty's intents and purposes, and
>
> (2) to prevent persons, over which it has control, from either defying the treaty's intents and purposes, or from perpetrating frauds under the treaty on other nations adhering to the treaty.

It is against the interests of "public welfare" to extend benefits under an international treaty to one who, for selfish purposes, has both acted in derogation to the intent and purpose of the treaty and has also employed the treaty in

such a manner as to defraud another country adhering to the treaty.

The "public welfare" purposes of treaties, and the obligations of the U. S. to support the treaties to which it is a party, and basic equity principles, as enunciated by the Supreme Court in the cases cited, compels granting this Petition for Certiorari to permit the Supreme Court to rule on this question of great public importance.

II. The Conflicts Between Courts of Equivalent Standing, Created by the Opinion of the Fourth Circuit, Can Only Be Resolved by the Supreme Court, and Certiorari Should Be Granted.

The opinions of the Court of Appeals for the Fourth and Seventh Circuits are in direct conflict. The Fourth Circuit found patent 2,210,846 valid, and the Seventh Circuit found the same patent invalid. The conflict should be resolved. *Universal Oil Co.* v. *Globe Oil Co.*, 322 U. S. 471, 473; 64 S. Ct. 1110, 1111.

The Seventh Circuit found the '846 patent to be invalid in view of the British patent to Felten, No. 6012, of 1909. In comparing Felten and Aghnides the Seventh Circuit said (210 Fed. 2d 859, 862) (Appendix B, *infra*, page xxiv):

> "* * * Felten introduced ozone into water under pressure and mixed them. Aghnides introduced air into water under pressure and mixed them. Each called his process one for mixing a gas with a fluid. *Felten reads literally on the claims of Aghnides.*" (Emphasis ours.)

The Fourth Circuit's opinion nowhere points out wherein Felten fails to read literally on the claims of Aghnides, as the Seventh Circuit has stated, and hence the Seventh Circuit's statement stands unchallenged.

The Court of Appeals of the Fourth Circuit (and the

Trial Court before it) erred in three important respects in disregarding the Seventh Circuit's opinion:

First: The Fourth Circuit Court placed great emphasis on commercial success (Appendix A, *infra,* pages iv to v, viii), completely disregarding this Court's admonition that commercial success cannot make an invention where there is none. *Jungerson* v. *Ostby & Barton Co. et al.,* 335 U. S. 560, 567; 69 S. Ct. 269, 272.

Second: The Fourth Circuit's Opinion states (Appendix A, *infra,* page iii) that Judge Hayes concluded in effect that:

> "* * * Felten operated on a different principle and did not achieve the result of Aghnides."

However, that conclusion, affirmed by the Fourth Circuit's Opinion, is completely contrary to the Opinion of the Seventh Circuit and to the unquestioned facts in this case.

What the alleged "different principle" is, cannot be discerned either from the patent's specification, the claims of the patent, or from the facts educed at the trial. It is not controverted that both Aghnides (2 App. 1-4) and Felten (2 App. 275-277) use a jet of water for creating a suction that sucks air through a lateral inlet into a mixing chamber, and, therefore, Aghnides and Felten are qualitatively the same. Aghnides sucks air. Felten sucks air which contains ozone (2 App. 275). Aghnides uses screens as a resistance for mixing the water and air. Felten uses perforated plates as a resistance to mix water and ozone-air (2 App. 275-277). Both devices produce a bubbly non-splash stream, as is disclosed in the trial record (1 App. 145, 149, 154)—and as was also noted by the Court of Appeals of the Seventh Circuit, before whom tests were run in open court (Appendix B, *infra,* p. xxiv).

As to the quantitative results achieved, while both the Trial Court and the Court of Appeals state that Felten

does not obtain the same results, it is uncontroverted that Aghnides admitted in his foreign patents, corresponding to patent 2,210,846, that his resultant jet:

> "* * * may comprise 30 to 40 per cent by volume of air" (2 App. 392).

The tests of the Felten device in open court, which were made by Aghnides on models that Aghnides himself had constructed, showed that Felten produced a resultant jet having:

(a) 33⅓% by volume of air (test of Plaintiff's Exhibit 44; 2 App. 217) and

(b) 41.2% by volume of air (test of Plaintiff's Exhibit 56; 2 App. 217).

Thus, the facts herein established that Aghnides and Felten are, contrary to the Fourth Circuit's Opinion, the same both qualitatively and quantitatively.

Third: In disregarding the fact that the Claims of the Aghnides patent read on Figure 8 of patent 2,210,846, the Court of Appeals of the Fourth Circuit not only ignored the Seventh Circuit's opinion and misapplied the applicable law, but also ignored unequivocal admissions in the file wrapper of the patent and decided this case in direct conflict with many decisions of the Court of Customs and Patent Appeals involving similar fact situations, thereby creating an additional conflict between courts of equivalent standing, which conflict may be resolved only by this Court.

The Seventh Circuit had stated (210 F. 2d 859, 863):

> "* * * It seems to us utterly immaterial that Felten's apparatus may also be used as a vacuum pump; so indeed may one form of Aghnides. Element for element, the two are the same." (Appendix B, *infra*, page xxv.)

In so stating, the Seventh Circuit was referring to Figure 8 of the Aghnides patent.

In drawing an issue between its decision and the decision of the Seventh Circuit, the Fourth Circuit stated (Appendix A, *infra*, page ix):

> "* * * We consider it immaterial that Figure 8, which is not covered by any of the claims, was not omitted in the granted patent."

And further, in discussing the Seventh Circuit's opinion, the Fourth Circuit stated (Appendix A, *infra*, pages ix to x):

> "* * * The reference must have been to Figure 8, the only form of Aghnides that can function as a pump; *but this form is outside the claims,* because it does not respond to their terms or produce the desired result of an aerated stream." (Emphasis ours.)

Nowhere in its decision does the Fourth Circuit show how Figure 8 does not respond to the terms of the claims. Furthermore, during prosecution of the application in the Patent Office, Aghnides had stated (2 App. 95):

> "Claim 55 (Claim 2 of the issued patent) is along the same lines as Claim 54 (Claim 1 of the patent) but specifies a means for finely breaking up the water and for offering sufficient resistance for thoroughly mixing it with air, and other means for uniting the aerated water to form a coherent jet. *This form of claim will read on Figs. 4, 5, 6, 7 and 8.*" (Emphasis ours.)

Thus, Aghnides asserted positively that the claims of the patent read on Figure 8. And in his Brief before the Board of Appeals, Aghnides stated (2 App. 106-107) that all of the modifications shown in Figures 1, 2, 4, 5, 6, 7 and 8:

> "* * * produce the same kind of a coherent white jet and make it in the same manner * * *"

And, furthermore, the Patent Examiner agreed with Aghnides as to the readability of the claims, and asserted

to the Board of Appeals that claims which issued in the '846 patent, read on the species of Figure 8 (2 App. 104).

When Figure 8 was again called to the Fourth Circuit's attention by Kress' Motion for Rehearing, the Fourth Circuit Court then conceded in its Supplementary Opinion that devices covered by the claims of the patent embody the Venturi principle as also embodied in Figure 8 (Appendix A, *infra*, page xviii), but still insisted that the patent claims call for "more", and insisted that the "more" is not found in Figure 8. In explaining re the "more" the Fourth Circuit noted that Figure 8 uses a *fluid* flowing through a pipe for drawing to itself *fluid* from another pipe, while the patent claims are directed to *water* flowing through a pipe for drawing to itself *air* (App. A, page xviii). While the Court was thus differentiating between Figure 8 and the patent claims, it failed to observe that *Felten* is the same as Figure 8 plus the same "more" that the Court itself had stressed—namely, Felten provides a Figure 8-type device wherein *water* flows through a pipe for drawing to itself *air*, and hence the patent claims, since they include and read on Figure 8 plus "more", must also read on *Felten*.

Additionally, Aghnides' present position, as sustained by the Court of Appeals for the Fourth Circuit, that certain forms of his device shown in his patent are patentable over, and with respect to the admittedly old alternate form of device shown in Figure 8, is in *direct conflict* with a time-tested and uniformly adhered to rule of Patent Law that has many times been reiterated by the Court of Customs and Patent Appeals[11] (a Court whose Appellate

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11. Some of these CCPA cases are:
Application of McCarn, 212 F. 2d 797, 799 (CCPA-1954);
Application of Stewart, 222 F. 2d 747, 754 (CCPA-1955);
Application of Lindberg, 194 F. 2d 732, 736 (CCPA-1952);
and the many supporting cases cited in these decisions.

jurisdiction is at the same level as that of the Court of Appeals of the Fourth Circuit) to the effect that:

> Where the inventor's own specification discloses an equivalency between two alternate constructions, and where one of the alternative constructions is anticipated by the prior art, the inventor may not argue for patentability with respect to one of the alternatives as compared to another.

Aghnides' position, as sustained by the Court of Appeals for the Fourth Circuit, is that certain of the alternative constructions shown in the Aghnides patent are patentable with respect to the alternative shown in Figure 8. But under the rule of law enunciated by the CCPA, an inventor may *not* argue for patentability of one alternative as compared to another. This conflict between Courts of equivalent standing should be resolved.

The foregoing errors clearly point up the conflict that exists between the decisions of the Court of Appeals of the Seventh Circuit and the Court of Appeals of the Fourth Circuit on the question of validity of patent 2,210,846. This question can ultimately be decided only by this Court.

III. A Decision by the Supreme Court of the Issues Raised Would Settle the Confusion Created by the Conflicting Opinions and Would Forestall Excessive Future Litigation Involving Patent 2,210,846.

The conflict in decisions between the Fourth and Seventh Circuits will now create confusion as to what the law should be with respect to the validity of patent 2,210,846.

There are four (4) other cases involving this patent awaiting trial, two of the cases being in the New York District Court, and the remaining two being in the Chicago District Court (see footnotes 3 and 4 *supra*, on page 3

of this Petition). Both of these courts have crowded calendars.

Unless the issue of validity of this patent is decisively resolved by this Court, there will be a tendency to litigate each and every one of those cases, as the patentee Aghnides has shown his disposition toward trying and retrying, again and again, the question of validity of this patent before the Courts (See Judge Schnackenberg's Opinion, in Appendix C, *infra*, pages xxix to xxx). The uncertainty which exists throughout the United States as to the validity of this patent, now enhanced by the conflict in decisions, will probably lead to expensive and time-consuming trials of the pending cases, and to Appeals of those cases to the various Courts of Appeals.

The inability of lower courts to remedy this situation respecting this particular patent was the basis of Judge Schnackenberg's separate concurring opinion in the *Holden* case reported at 226 F. 2d 949 at page 951 (Appendix C, *infra*, pages xxix to xxx).

In the interests of uniformity of decisions, and to forestall excessive consumption of lower courts' time, this Petition should be granted.

CONCLUSION.

For the reasons stated, this Petition for Writ of Certiorari should be granted.

Respectfully submitted,

WILL FREEMAN,
NORMAN LETTVIN,
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Attorneys for Defendant-Appellant.

September 23, 1957.

(Appendix Follows)

APPENDIX A.

UNITED STATES COURT OF APPEALS
For the Fourth Circuit.

No. 7294.

S. H. Kress & Company,
Appellant,

versus

Elie P. Aghnides and
Chase Brass & Copper Company, Inc.,
Appellees.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE MIDDLE DISTRICT OF NORTH CAROLINA, AT GREENSBORO.

(Argued January 9, 1957. Decided May 17, 1957.)

Before PARKER, Chief Judge, and SOPER and SOBELOFF, Circuit Judges.

SOBELOFF, Circuit Judge:

From a decree of the District Court holding valid and infringed two patents relating to devices for aerating water, particularly adapted for use in household faucets, this appeal was taken. The patents are 2,210,846, issued to Elie Aghnides, August 6, 1940, and 2,316,832 for an improvement thereon, issued to him April 29, 1943. The suit was

originally filed by the patentee, but later Chase Brass & Copper Company, Inc., holder of a license from him, took an assignment of the patents and, by leave of Court and with the consent of the defendant, became an additional party-plaintiff.

The purpose of the patented devices is to obtain a coherent, aerated stream of water that will not splash as it emerges from a domestic faucet. The device is attached to a kitchen water tap and consists essentially of a chamber into which both water under ordinary pressure and air are delivered and intimately mixed so that the stream issuing therefrom is a mixture of water and entrained bubbles. Because of the great volume of air in the mixture the water is soft and produces a large volume of suds when mixed with soap. The result is effected by projecting water through small apertures in a diaphragm at the upper or inlet end of the chamber, thereby breaking the water into mulitple jets as it enters into the chamber. Air is drawn into the chamber through openings in the side and is mixed with the water therein as a result of turbulence of the water as it strikes resistance elements in the chamber preventing the free through-flow of the water. At the outlet of the chamber a fine screen or screens are located. The combination is typically described in the first claim of the basic patent '846, which is quoted in the margin.[1]

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1. "A device for producing a coherent jet of water containing air bubbles, comprising a chamber, the inlet end of which is adapted for connection with the discharge end of a tube containing water under pressure and the outlet end of which is adapted to discharge the said coherent jet, a diaphragm at the upstream end of the chamber having at least one orifice through which the stream of water is adapted to be forced into the chamber with substantial velocity, an air port opening into the chamber through which air is induced by the stream of water, and means, in the path of the stream of water after it leaves the orifice and before it discharges at the outlet end, for finely breaking up the water and for offering sufficient resistance for thoroughly mixing it with air and for thereafter uniting the aerated water to form a coherent jet having small bubbles disseminated throughout the jet."

The improvement patent, '832, combines the basic elements of the above with a second perforated diaphragm or restricted orifice, or both, at the upstream end of the aerator, to obtain a more perfect stream of soft, splashless, bubbly water.

The District Judge held both patents in suit valid and infringed, in spite of the fact that the first patent, '846, had previously been declared invalid by the United States Court of Appeals for the Seventh Circuit because anticipated by the Felten English patent. *Aghnides* v. *Goodrie,* 210 F. 2d 859. The District Judge's opinion observed that in approaching his task he felt constrained to follow the Seventh Circuit if the evidence warranted it. Expressing proper deference for the opinion of that Court he, however, found himself unable to agree with it. As the Court of Appeals itself declared in *Aghnides* v. *Holden,* 226 F. 2d 949, its *Goodrie* decision is not *res adjudicata,* even in the same Circuit, since there was no privity between the defendants in the two actions.

After a long trial and many experiments conducted in his presence in the courtroom, District Judge Hayes concluded that Felten operated on a different principle and did not achieve the result of Aghnides. One after another of the observations made in the *Goodrie* opinion, suggesting similarities between Felten and Aghnides, were fully answered by highly persuasive visual evidence to the contrary.

The same Rule of Practice (Rule 52(a) F.R.C.P.) upon which our brethren in the Seventh Circuit relied in upholding the findings of their District Judge as not clearly erroneous would warrant our putting equal reliance in the presumptive correctness of District Judge Hayes' contrary conclusions. However, to avoid unnecessary conflict between the Circuits, we deemed it our duty to address ourselves independently and with special care to an examina-

tion of the District Court's findings. Of course, our review is of the record made in the District Court below, which is different from the *Goodrie* record, and appears to be more detailed and comprehensive.

Turning more particularly to the '846 patent, it may be noted that in the instant case, further supporting this presumption of correctness is the provision of the Patent Act (35 U.S.C.A. 282), which puts the burden of establishing invalidity upon the party asserting it; and the usual presumption of validity is strengthened by the history of this patent in the Patent Office. It was granted only after considerable controversy and after review by the Board of Appeals, where the references relied upon by the defendant were all closely considered by administrative officials possessing special competence in the field.

It is noteworthy that 21,000,000 units embodying the patented device have been sold in this country, and licenses have been taken by large concerns like Chase Brass & Copper Co., Firestone Tire & Rubber Co., and Chicago Faucet Co. Chase Brass alone had up to the time of the trial paid royalties on more than 16,000,000 of its "Spring-Flo" units made according to the Aghnides teaching. Before taking the license it had conducted an extensive search of the art and made unsuccessful attempts to attain the results of the Aghnides invention by other means. By the payment of substantial royalties, such business concerns attest their opinion of the merit of the patent. While it is true that commercial success does not determine either invention or the validity of a patent, nevertheless, in a doubtful case it may be a convincing factor. *Great Atlantic and Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 153; *Textile Machine Works* v. *Hirsch Textile Machines, Inc.*, 302 U.S. 490, 498; *Smith* v. *Ball*, 301 U.S. 216, 233. Before this invention, no water aerator that could be used in connection with a household faucet had

been successfully marketed. The wide acceptance and use of this item, which has become standard equipment in the plumbing supply industry and is used by leading faucet manufacturers and has been installed in millions of homes, are circumstances not without significance.

Like the District Court, we are unable to agree that this patent was anticipated by the Felten British patent No. 6012 of 1909, or the corresponding United States patent No. 1,090,044, issued to Fuss. The drawings of the Felten patent have a superficial resemblance to the patent in suit, but on closer examination Felten will be found to be different. Felten operates on a different principle, is designed to achieve a different result, and has never been utilized, as has the plaintiffs' patent, to supply the householder with a soft, coherent, splashless stream of aerated water. The purpose of the Felten patent was to add ozone to water to sterilize it, and it is not shown that it was ever actually used even for this purpose. Judge Hayes had the benefit of witnessing the operation of demonstration equipment—a tank with faucets for the attachment of aerators, with a pump for circulating water from the tanks through the faucets, and with a pressure gauge and a vacuum gauge. The testimony is singularly free from the confusions which often creep into the record of courtroom demonstrations, and is clear and understandable. With respect to the Felten patent, the Court found (Finding XXVII (f)):

> "This device is also designed to secure a vacuum. Models thereof were demonstrated to the Court by plaintiff from which Felten's construction, mode of operation and results were made evident. Felten's device does not produce the fully aerated, soft, stream characteristic of Aghnides and does not operate on the same principle or use the same combination of elements. * * *. Felten is so constructed that the energy of the water is spent in creating a vacuum and not in securing aeration. Demonstration showed that it adds less than 5/10 of a cubic inch of air to 1 cubic inch of

water whereas Aghnides' aerator adds 6 cubic inches or 12 times as much.

"Not only was it demonstrated that Felten's result is different but that he secures his result by different elements and by a different mode of operation. The patent states that the result is secured by means of a 'conically widening chamber e, the widening of which produces in a well known manner the suction of the gas from the perforation d owing to the flow of the liquid from the perforation c into the widened chamber e'. (Felten Patent, p. 1, line 28). This has no counterpart in Aghnides. Felten, to secure his result, must keep the chamber flooded—the exact opposite of Aghnides. This was demonstrated by a transparent model (Exh. 44) which made it possible to see that the widening chamber was at all times flooded and that there were no individual jets striking Felten's baskets. The flooding of the chamber was also demonstrated by drilling a hole into a widening chamber whereupon water squirted out and, when the air through the inlet provided by Felten above the chamber was cut off no air entered any place and the device became inoperative even as a vacuum pump. Felten's necessity for flooding was also demonstrated by eliminating the flooding (by removing the outlet baskets) under which circumstances the device produced a mere jet of water with neither vacuum nor aeration. This is a fundamentally different mode of operation than Aghnides as could be seen from the demonstration of an Aghnides' aerator with the sides cut out (P. Exh. 39). The chamber in Aghnides is not a widening one as in Felten and was not flooded but on the contrary contained only the naked water jets in free air striking his resistance screens.

"The fundamental nature of the difference between the Felten device and the Aghnides' aerator was also visually demonstrated to this Court by providing a Felten device (P. Exh. 42) with greatly increased resistance below his baskets—in the amount of 21 screens! The device none the less created substantially the same amount of vacuum as it did without the

screens, showing that the intended function of the device was not changed even by a great change in the amount of resistance. On the other hand, when the resistance of an Aghnides' aerator (P. Exh. 42) was increased by adding only three screens its proper proportioning was destroyed, the device flooded and it became useless for its intended purpose. It was also demonstrated that Felten's baskets are not essential to his operation and are not elements corresponding to Aghnides' essential resistance screens or shoulders; when Felten's baskets were removed, his device would still operate with a flooded chamber and produce his high vacuum."

The foregoing findings are supported by substantial evidence, pointed and convincing, and we are persuaded that they should not be set aside. They show that while in Felten some air was present, increase in the amount of air would defeat the operation of the device, since what was desired was a vacuum; whereas in Aghnides the presence of a large quantity of air was desired to effect aeration, which is the heart of the invention. Unless these solidly grounded findings are to be disregarded completely, we must conclude that the Felten British patent No. 6012 of 1909 and the corresponding United States patent, Fuss, No. 1,090,044, do not anticipate the patent and do not indicate invalidity for lack of invention thereover.

The other patents cited by the defendants also failed to produce the objective of the Aghnides device. They were never applied to the purpose of the Aghnides patent. In Court these earlier patents emitted violent, splashing, divergent streams without the desired aeration. None of them refers to the problem to which Aghnides addressed himself. The prior art patents, other than Felten, which were chiefly relied on by the defendant, are Solomon and Hyatt. The Solomon British patent No. 405,316, for example, intended to aerate beer, produces no bubbly stream comparable to

that produced by the Aghnides device. The admission of a slight quantity of air increases froth on beer sufficient for the desired purpose. It will not perform the same function as Aghnides, as was demonstrated before the Trial Judge. The British patent Hyatt, No. 326,221, is a massive device for purifying water for cities or large industrial installations, and is not addressed to the objective of delivering an aerated stream of water at the point of use.

Other patent references are even wider of the mark. None is the counterpart of patent No. 2,210,846 in principle, operation, or results, as the demonstrations proved step by step and in detail. Even the speculations as to how certain modifications in pre-existing devices might adapt them to achieve the desired result were refuted by actual experiments in open court. The demonstrations in the District Courtroom are entitled to special weight, because resemblances and differences not readily noted from verbal descriptions or graphic illustrations were made vivid by use of models constructed of transparent material to make the operation of the various devices of the experiments clearly visible.

The usual defense that the result would have been obvious to one skilled in the art cannot avail the defendant here. Obviousness does not mean that one skilled in the art can perceive the solution after it has been found and pointed out by someone else; the test of obviousness is as of an earlier time, when the search is on. If the answer to the riddle were in fact discoverable as readily as the defendant now claims, it seems incredible that with a latent demand strong enough to result in the sale of 21,000,000 units of this device, the persistent researchers in the industry who were engrossed by the problem would have been blind to the solution found by Aghnides.

We conclude that the '846 Aghnides device was inventive and not merely within the ordinary skill of the art; and

that it was not anticipated by the prior art. The District Judge's findings are not only adequately supported, but accord with our own appraisal of the evidence. . . .

Defendant contends that because plaintiff admits that Figure 8 of the '846 patent[2] is the prior art, the claims in the patent are invalid. The complete answer is that the claims are not directed to this figure and do not read upon it any more than they read upon Felten. The scope of the claims is controlling, not the figures in the drawing. A form shown in a drawing is not necessarily covered by the granted claims. When an application for a patent is filed, many forms may be shown and an attempt made to cover them all in the claims as originally presented. During the prosecution of the application, however, the claims may be restricted in the light of the prior art. In the end, only certain of the forms shown may be covered by the restricted claims. Whether the forms not covered by the surviving claims remain in the patent or are cancelled from the drawing is immaterial, for the claims, and not the drawings, control. We consider it immaterial that Figure 8, which is not covered by any of the claims, was not omitted in the granted patent. *Denominational Envelope Co.* v. *Duplex Envelope Co.*, 4 Cir., 80 F. 2d 188, 192; *Bassick Co.* v. *Faultless Caster Corp.*, 7 Cir., 105 F. 2d 228, 231; see also *Freedman* v. *Friedman*, 4 Cir., 242 F. 2d 364.

The opinion of the Seventh Circuit commented on the fact that one form of Aghnides' device may be used as a vacuum pump and, apparently, largely for this reason, invalidated the Aghnides patent as an equivalent of Felten's prior patent. The reference must have been to Figure 8, the only form of Aghnides that can function as a pump;

2. Figure 8 illustrates a device for mixing two or more fluids. It exemplifies what is known to the prior art as the Venturi principle, namely, that a stream of fluid under pressure in a pipe of increasing diameter will create a suction and draw to itself the fluid from a converging pipe.

but this form is outside the claims, because it does not respond to their terms or produce the desired result of an aerated stream.

Contesting the charge of infringement, the defendant undertook to distinguish the accused device, called "Mel-O-Flo," manufactured by Melard Manufacturing Co., from that of the plaintiffs. The defendant's aerator has, at the top of the chamber, a diaphragm with small orifices through which the water from the faucet goes, and below the diaphragm is a casing with lateral holes for the admission of air. The diaphragm is formed by a ring and a plate that is seated in the ring. The plate is provided with teeth. The plate itself is not perforated, but when the parts are brought together, there are openings around the border through which the water can escape downward. This is substantially like the apertured plate or plates at the upper end of the chamber in the plaintiff's device.

The defendant's contention of non-infringement is that the accused device, unlike that of the plaintiffs, does not utilize "resistance screens" to effect break-up or mixing of the water and air. The claims of the patent, however, are broader and are not limited to such screens. As pointed out above, claim one simply calls for "means in the path of the stream of water . . . for finely breaking up the water and for offering sufficient resistance for thoroughly mixing it with air . . . ." Clearly, this language applies as well to the accused structure as to numerous figures of the '846 patent. The fact that the defendant's structure uses an "onion" and the inner surfaces in the chamber and a single outlet screen to create the necessary resistance, whereas Aghnides uses a plurality of screens, is an immaterial circumstance. They are equivalents in every sense. The claims of the '846 patent clearly read on the defendant's structure. See *Graver Mfg. Co.* v. *Linde*, 339 U.S. 605, 607.

The second patent, '832, which is claimed to be an improvement upon the first, covers the same general combination as the basic patent, plus an added element, an additional apertured diaphragm in the upper part of the chamber, or a restricted orifice upstream of the chamber, or both. This is set forth in claim one as a "foraminous member upstream of the apertured diaphragm"; in claim two as a "restricted orifice upstream of the apertured diaphragm"; in claim three as a "restricted orifice and foraminous member upstream the apertured diaphragm"; and in claim four as "superposed apertured diaphragms at the upstream end of the chamber through which water is adapted to be forced into the chamber with substantial velocity."

But the Aghnides original, or '846 patent, had already taught the use of a perforated diaphragm at the upstream end of the chamber to force water into the chamber with substantial velocity. Merely adding another perforated diaphragm or diaphragms at the upstream end, or another screen or screens at the outlet end, introduces nothing new, especially as the earlier patent had shown that perforated plates or screens could be used in either position, and that "even better results can be obtained if two or more superposed screens are used in the outlet discharge." Adding interchangeable screens or diaphragms at the other end is merely a means of maintaining the proportion between inlet and outgo, and does not rise to the level of invention over the earlier patent. Nor does the second feature of the '832 patent introduce novelty in the device or in the result to be achieved by it. Merely noting that "when the water is discharged [into the chamber] through a restricted orifice [a narrow pipe] that the flow through the orifices in the upstream diaphragm is improved," is—in the context of all that had gone before, including Aghnides' own contribution—too meagre a discovery to be regarded as invention.

The changes seem to be the normal and obvious result of skill and experience gained in the practice of the '846 invention. They are entitled to no new patent, for they are variations in the application of the principle already disclosed, and are of no important consequence mechanically and should be accorded no significance legally. We conclude that the '832 patent is invalid. See *Atlantic Works* v. *Brady*, 107 U.S. 192, 200; *Wine Ry. Appliance Co.* v. *B&O R.R. Co.*, 4 Cir., 78 F. 2d 312, 319, and others there cited.

A considerable portion of the defendant's briefs and the argument before us was concerned with matter not in the record, but attempted to be raised by motion to reopen the case many weeks after the conclusion of the trial, which lasted over a long period of months. Therein the defendant offered to show that Aghnides had represented to the Canadian Patent Office that the inventions of his Canadian applications corresponding to the patents in suit were not the same inventions as those covered by a prior Belgian application made by Aghnides; whereas in the United States, to get the benefit of an earlier date, he had previously represented that the invention of the United States application was the same as that of the prior Belgian application.

Ordinarily, whether or not a case shall be reopened for the reception of additional testimony is in the discretion of the Trial Judge, which discretion will not be disturbed on appeal. Particularly is this so where the party moving to reopen has had long and full opportunity to develop the information he now seeks to present, but did not do so during the pendency of the trial. In this case, we are the more strongly disinclined to interfere with Judge Hayes' exercise of discretion, because on the documents before us, we fully agree with his comment that even if the case were reopened, the proffered testimony would not alter the result.

From our own examination of the United States patent '846 and the Belgian patent, we think it unquestionably true that they are, as Aghnides told the United States Patent Office, the same invention. Whether or not on another occasion Aghnides made an inconsistent claim in Canada to obtain a patent there, is an issue that we need not decide. If he made a misstatement there, this might bear upon the validity of his Canadian patent. It would not alter the fact that what he told the United States Patent Office was the truth and that the patent here was obtained without deception or fraud. Even if we were to assume what we are not prepared to adjudicate, that the inventor's representations to the Canadian Patent Office were untrue, this misconduct would not be so closely related to the proceedings in this country and the issuance of the patent to him here as to invalidate the grant or to constitute such unclean hands as to disentitle him to the relief he asks in this case.

Defendant complains of the trial court's failure to dismiss the complaint as to Chase Brass and Copper Company, Inc. The argument is that although Chase became a party plaintiff with the consent—almost insistence—of the defendant, and defendant does not complain of the intervention of Chase, nevertheless, no relief should be entered in favor of this plaintiff and the case should be dismissed as to it, because Chase failed to prove infringement after the assignment of the patent to it. Yet the defendant argued that no injunction should be granted at the instance of Aghnides, because he no longer is the owner of the patent. Accordingly, although the Court has before it Aghnides, who was the owner when the infringement occurred, and Chase, his assignee, injunctive relief, it is said, is not to be allowed. We find no merit in the defendant's contention,

raised for the first time on this appeal, especially as it consented to the admission of Chase and announced its intention to utilize against Chase any decree that might be rendered against it. With all parties in interest before the Court, it was in a position to do complete justice.

Affirmed in part and reversed in part, and remanded for the passage of a decree in conformity with the views herein expressed.

APPENDIX A.

UNITED STATES COURT OF APPEALS
For the Fourth Circuit.

No. 7294.

S. H. Kress & Company,
Appellant,

versus

Elie P. Aghnides and
Chase Brass & Copper Company, Inc.,
Appellees.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE MIDDLE DISTRICT OF NORTH CAROLINA, AT GREENSBORO.

Before PARKER, *Chief Judge* and SOPER and SOBELOFF, *Circuit Judges.*

SUPPLEMENTARY OPINION ON MOTIONS FOR REHEARING.

Filed July 9, 1957.

PER CURIAM:

Both parties have submitted motions for rehearing. The plaintiffs contend that the Court's opinion, in holding the

improvement patent No. 2,316,832 invalid over the basic patent No. 2,210,846, ignored the rule as to co-pending patents.

Ordinarily, a patent, to be valid over the prior art, must be an advance over the *whole disclosure* contained in the specifications or claims of a prior patent. This rule will normally apply even where the applicant is the same person to whom a prior patent was issued, because whatever is *disclosed* but not claimed by the former patent will be considered as abandoned to the public. However, where the applicant files a second application while the earlier one is still pending in the Patent Office, and the first patent contains disclosures not embodied in the claims, he is not barred from embodying the unclaimed disclosures in the later application. In such case, because the first application has still not been made public when the second is filed, the unclaimed disclosures of the first patent are not deemed an abandonment preventing their being claimed in the second. *Traitel Marble Co.* v. *Hungerford Brass and Copper Co.*, 2 Cir., 22 F. 2d 259, 261.

To be patentable, however, the claims of the second patent must be for a different invention than that claimed in the first patent. *Traitel Marble Co.* v. *Hungerford Brass and Copper Co.*, supra; *Montgomery Ward* v. *Gibbs*, 4 Cir., 27 F.2d 466; *Jordan* v. *Hemphill*, 4 Cir., 180 F.2d 457; *Standard Brands* v. *Federal Yeast Corp.*, D. C. Md. (Soper, J.), 38 F.2d 314; *Weatherhead Co.* v. *Drillmaster Supply Co.*, 7 Cir., 227 F.2d 98; *Danbury Fur* v. *American Hatters*, 2 Cir., 54 F.2d 344; *Sturtevant* v. *Massachusetts Hair Co.*, 1 Cir., 122 F.2d 900; *In Re Sherman*, C.C.P.A., 121 F.2d 527. If the second application merely claims the same invention on which the applicant has already been awarded a patent, he will, of course, not be permitted, by double patenting, to extend his monopoly beyond seventeen years. The policy of the law is to protect the inventor by granting

him a monopoly for a limited term, but upon its expiration the public is entitled to practice his invention in all its modifications and variations. There is certainly no reason to grant him a monopoly for an extended period upon a variant of his patent which would be obvious to one skilled in the art.

The *Traitel* case, supra, in which the opinion was by Judge Learned Hand, is sometimes cited for the proposition that the claim of the second patent need not be inventive at all, if the application is filed while the applicant has a pending prior application. But a careful reading of that opinion, as well as the other cases cited above, shows that what Judge Hand meant and said was that the claim of the second application need not be a patentable advance over the *disclosures of the specifications* (as distinct from the claims) of the first application. All agree that a patentee cannot re-claim what has already been claimed and patented by him.

Neither the narrowing of the inlet end of the aerator, nor the addition of "a foraminous member" makes the second patent a separate invention. Even disregarding the specifications and looking solely at the claims of the two patents, it is plain that the two involve the same patentable invention. The claim of the second patent speaks of "a foraminous member upstream the apertured diaphragm," while the claim of the first patent mentions only the upstream "diaphragm"; but the terms mean the same thing. It is true that in the claims of the first patent, only one such diaphragm is prescribed, while the claim of the second is for more than one such member; but there is no significant difference between the claims of the two patents.

Changing some of the functioning parts of a device may constitute an independent invention, but merely adding more of the same thing is not ordinarily a separate invention. For example, in the *Gibbs* case, supra, of the five major

functioning parts of the second patent, only two had appeared in the claims of the earlier patent, and what the court considered the heart of the second patent was not claimed in the first. By contrast, in our case, nothing new or different is claimed in the second patent that was not in the claims of the first.

DEFENDANT'S MOTION.

Defendant's motion for rehearing alleges error in the opinion with regard to the discussion of Figure 8 in the basic patent No. 2,210,846. We held that the claims do not read on Figure 8. The defendant's petition for rehearing says that the plaintiff has admitted that his claims operate, like Figure 8, on the Venturi principle. While this is true, it does not follow that the claims read on Figure 8, because although they utilize the Venturi principle, they do not operate on that principle alone. Figure 8 embodies the Venturi principle only, and nothing more; it provides merely for a pipe, with a fluid flowing through it, drawing to itself the fluid from another converging pipe. The claims, however, which relate not to figure 8 but to the other figures, are for a device designed to draw air to the pipe containing water, and to break up the water, mix it with air, and achieve aerated water.

Both motions for rehearing will be

Denied.

APPENDIX B.

IN THE UNITED STATES COURT OF APPEALS
For the Seventh Circuit

No. 10910 OCTOBER TERM, 1953, JANUARY SESSION, 1954.

ELIE P. AGHNIDES,
Plaintiff-Appellant,

vs.

JOSEPH J. GOODRIE, ET AL.,
Defendants-Appellees.

Appeal from the District Court of the United States for the Northern District of Illinois, Eastern Division.

February 24, 1954.

Before MAJOR, *Chief Judge*, LINDLEY and SWAIM, *Circuit Judges.*

LINDLEY, *Circuit Judge.* Plaintiff's suit for infringement of his patent 2,210,846, applied for in the United States December 31, 1937, and in Belgium December 8, 1934, and allowed August 6, 1940, having resulted in a judgment of invalidity and dismissal of the action, he brings this appeal.

The device of the patent is not complicated in structure or operation. The inventor described it as a "fluid mixing device," "for intimately mixing a gas with a fluid." Apparently the only practical use experienced has been in mixing air and water, or "aerating water." Claim 1 which is typical of all, five in number, appears in the foot-

note.[1] It is clear that the patentee's conception envisaged an attachment for a water tap from which water flows under pressure and enters the contrivance at the top, passes through an aperture or apertures or a screen near the top thereof thus dividing and separating the stream as it continues into a mixing chamber, into which incoming air enters through air ports leading into the chamber, thus mingling the air with the rushing water. The mixture of air and water then continues to the outlet, passing over barriers or screens, thus causing to flow from the outlet into the kitchen sink or other receptacle an aerated stream of water, which falls in what is called a "coherent" stream whitish in color, due to the added air, without splashing or spattering. It is said also that such aerated water lends itself more readily to the efficient use of soap. Thus the housewife finds the "mixer" or "aerator" helpful in her housework. The whole idea then embraces water under pressure flowing from an open faucet into a chamber after it has been divided by a screen, then subjected to added air, plus a further breaking up, after the air has been added, by another screen or barriers and then released. The application, as plaintiff admits, had "a stormy time in the Patent Office" and was first denied on various references, but eventually allowed by the Board of Appeals.

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1. A device for producing a coherent jet of water containing air bubbles, comprising a chamber, the inlet end of which is adapted for connection with the discharge end of a tube containing water under pressure and the outlet end of which is adapted to discharge the said coherent jet, a diaphragm at the upstream end of the chamber having at least one orifice through which the stream of water is adapted to be forced into the chamber with substantial velocity, an air port opening into the chamber through which air is induced by the stream of water, and means, in the path of the stream of water after it leaves the orifice and before it discharges at the outlet end, for finely breaking up the water and for offering sufficient resistance for thoroughly mixing it with air and for thereafter uniting the aerated water to form a coherent jet having small bubbles disseminated throughout the jet.

The District Judge heard the testimony of the plaintiff, his expert and Mr. Goodrie, one of the defendants, received certain documentary evidence and observed certain tests of the patented, the allegedly infringing and other devices in open court, participated in by both parties. He had before him evidence bearing upon alleged commercial success and various references to the prior art. At the conclusion of the trial, he took the cause under advisement, giving the parties the privilege of filing written briefs and argument, the time for filing which was extended at various times. Finally, when they were all in, the judge, on November 3, 1952, announced his decision, saying: "In my opinion the Aghnides patent Number 2,210,846 upon which plaintiff relies in this case is anticipated by British patents Number 6012 of 1909 and 405316 of 1933 and is therefore invalid. Counsel may prepare findings of fact and conclusions of law and submit them to Casper W. Ooms as Special Master in this case for the purpose of passing on such findings and conclusions."

Following the Special Master's report on March 20, 1953, the court entered formal findings and conclusions, in which, after discussing the details of the patent, pointing out the salient elements of the prior art and describing the tests performed in open court, it found that all the elements of Aghnides were old in the art in the Felten British patent No. 6012 of 1909, its counterpart, No. 1090044 to Fuss 1914, and Solomon British patent No. 405,316 of 1933; that Aghnides' assembly of old elements performs no new or additional function, and achieves no new or unusual or surprising result but that the devices of the prior patents to Solomon and Felten achieved substantially the same results and that to produce the disclosure of the patent required no invention. The court concluded that the claims were anticipated by Felten and Solomon and were invalid

because of such anticipation and because of lack of invention.

At the outset we are met with plaintiff's contention that the findings are not entitled to the proverbial weight to be given trial court findings under Rule 52(a) of the Rules of Civil Procedure. He attacks only those heretofore summarized, insisting that they were proposed by the Master, who, though he had examined the oral and documentary evidence, did not see the tests performed in open court and that they were therefore wrongfully adopted by the court, after a protracted interval had intervened between the conclusion of the trial and the date of the entry of the findings. He argues that the court had forgotten the facts, and merely accepted the Master's proposals, which did not take into consideration the tests which the court had observed.

At the conclusion of the trial, November 15, 1951, both parties waived oral argument. After various extensions of time, plaintiff filed its brief and argument on May 22, 1952; thereafter defendants filed their brief and argument and plaintiff filed his reply brief. In September, 1952, Judge Holly suggested that, as he had been ill during the summer and unable to work on his decision, perhaps the parties would desire to have the case assigned to another judge. Counsel for both parties consulted and agreed that the case should remain with Judge Holly for decision. Consequently, with the consent of both parties, Judge Holly retained the case and finally, on November 2, 1952, entered the findings hereinbefore summarized that the patent in suit was anticipated and was invalid. At the same time he directed that both parties submit suggested formal findings to Casper W. Ooms, an erudite and experienced patent attorney and former Commissioner of Patents, as Special Master, to be considered by him. The formal findings and conclusions and judgment dismissing the suit were entered March 20, 1953. Denying a motion for new

trial on April 10, 1953, the court said that the findings were not affected by his illness in the summer of 1952 and that the motion for a rehearing was without merit.

The Master reported that there had been a dispute before him only as to findings 9 and 13 inclusive; that he had examined the evidence and that the findings suggested were based thereon and not upon the tests in open court and that he submitted them for such action as the court might consider proper upon the whole record. The Master did not make findings on the merits but explicitly stated that it was up to the court to do so, based upon the record and the court's knowledge of what had transpired at the trial. Of course, when the court entered the findings, they became its findings and not those of the Master; the latter's report was merely advisory; the court made the final determination. Furtherfore the formal findings adopted were in strict conformity with the court's decision before it asked the parties to suggest more formal findings and conclusions.

Under these circumstances, we find no justification for lending to the trial court's findings any less weight than we normally do under Rule 52(a). Consequently our question is the usual one of whether there is adequate evidence to support them. Such cases as *Sales Affiliates* v. *National Mineral Co.*, 172 F. 2d 608; *Falkenberg* v. *Golding*, 195 F. 2d 483 and *Chas. Peckat Mfg. Co.* v. *Jacobs*, 178 F. 2d 794, decided by this court, wherein we were dealing with records made up of documentary evidence, which we were as capable of interpreting as was the district court are not applicable here. The present case comes more clearly within our decision in *National Rejectors* v. *A. B. T. Mfg. Corp.*, 184 F. 2d 612, where we said at 615:

> "In view of the fact that the court, having seen the devices demonstrated and heard the witnesses, expert and otherwise, of each of the parties, having their conflicting testimony before it, made a finding which

has adequate substantiation in the record, under the federal rules of procedure, we have no right to interfere. *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271, 69 S. Ct. 535, 93 L. Ed. 672; *Hazeltine Research Inc.* v. *Admiral Corp.*, 7 Cir., 183 F. 2d 953."

We, too, have had the benefit of tests in open court at the time of the argument before us. We, too, have the transcript of the oral and documentary evidence. After careful consideration of all that has been presented, we think the trial court was amply justified in entering the findings and conclusions of which complaint is made. Indeed, we are of the opinion that any determination to the contrary would have been erroneous.

Felten is prior art. He designated his invention as "improvements in or relating to Mixing Devices" and as a "Mixing device for producing * * mixtures from a gas or vapor like substance and a liquid substance," and an "apparatus for mixing gases with fluids." The patent in suit uses similar language. "This invention relates to a device for intimately mixing a gas with a liquid." Felten introduced ozone into water under pressure and mixed them. Aghnides introduced into water under pressure and mixed them. Each called his process one for mixing a gas with a fluid. Felten reads literally on the claims of Aghnides. An asserted difference is that the mixing chamber of Aghnides is larger than that of Felten, but that, so far as the tests and the evidence shows, is not an inventive difference. Then, too, plaintiff insists that the air vent of Felten introducing air into the mixing chamber does not in fact lead into the chamber but only into the top thereof, thus weakening the mixing effect. Yet in both Felten and Aghnides, the vent enters the chamber just below the diaphragm, which in turn, is just below the intake for the water. Felten as well as Aghnides brings the gas into the mixing chamber. If in practice, it has proved

desirable to introduce the gas at a point lower than that indicated by either, that lower placement cannot amount to invention. The important thing is that each introduces a vapor, a gas, ozone or air, into moving water in order to mix the two substances. It seems to us utterly immaterial that Felten's apparatus may also be used as a vacuum pump; so indeed may one form of Aghnides. Element for element, the two are the same. In tests the two accomplish the same results, though perhaps not with equal efficiency. We conclude then that the trial court rightfully found that Felten anticipated Aghnides and taught the latter all that he needed to know in order to build his mixer of gas and fluid, i. e., air and water.

We think it unnecessary to prolong this opinion by detailed discussion of other prior art. Suffice it to say that in our opinion, after carefully examining it, the teachings of the other patents in evidence were such that, with them before him, Aghnides did not achieve invention.

If for the moment we indulge the presumption of validity, we think Aghnides' claims must be very narrowly construed and limited to the specific structure disclosed by him. Consequently, defendants, who do not employ the same structure, but prescribe a different means for separating the incoming water into jets, does not infringe.

We conclude that Aghnides was anticipated; that, if not fully anticipated, the prior art, of which he was bound to take notice, was such that any skilled delver in the art of mixing gases and fluids could have built Aghnides' device,—in other words, that he did not achieve invention but accomplish the result of a skilled mechanic.

In view of our conclusions we consider it unnecessary to extend this discussion to other points urged by the respective parties.

The judgment is

AFFIRMED.

APPENDIX C.

IN THE UNITED STATES COURT OF APPEALS
For the Seventh Circuit.

No. 11405. OCTOBER TERM AND SESSION, 1955.

ELIE P. AGHNIDES and CHASE BRASS AND COPPER COMPANY, INC.,
Plaintiffs-Appellants,
vs.
ORLOFF W. HOLDEN and MARGUERITE HOLDEN, doing business as KNICKERBOCKER RUBBER COMPANY,
Defendants-Appelees.

Appeal from the District Court of the United States for the Northern District of Illinois, Eastern Division.

November 3, 1955.

Before MAJOR, LINDLEY and SCHNACKENBERG, *Circuit Judges.*

LINDLEY, *Circuit Judge.* On July 19, 1950, plaintiffs filed a complaint in the district court against defendants, charging them with infringement of the patent to Aghnides, number 2,210,846. Issue was joined and the cause remained in *status quo* until the decision of this court on February 24, 1954, in *Aghnides* v. *Goodrie,* 210 F. 2d 859, wherein plaintiff Aghnides had sued other defendants for infringement of the same patent. In that case the district court had held each of the claims, five in number, invalid and, upon appeal, we affirmed the judgment. Following this decision, the defendants on November 4, 1954, in the suit

at bar then pending, filed a motion for summary judgment setting up the findings, conclusions and judgment of the district court and the decision of this court in the former case, claiming that there remained no genuine issue as to any material fact and that under Rule 56 of the Federal Rules of Civil Procedure, 28 U. S. C. A., they were entitled to judgment as a matter of law.

Plaintiffs filed an affidavit of the patentee in which he stated that he had made a new model of the prior art Felten device which we had held in the *Goodrie* case anticipated the patent in suit. He averred that he was prepared to conduct new tests and produce new evidence and show that the prior art Felten device did not accomplish the same results or have the same mode of operation as that of the patent in suit; that he was prepared to show by new and different models and tests of the prior art that the elements of the patented device are not old and do not perform the same functions as they performed in the prior art devices; and that, element for element, Felten and Aghnides are not the same and do not accomplish the same results. The trial court held that the suggested new evidence was not fairly distinguishable from the evidence in the *Goodrie* case, our decision in which established the invalidity of the plaintiffs' patent, and that, as a matter of law, defendants were entitled to judgment. This appeal followed.

Defendants argue that the affidavit of Aghnides is general and not specific; that it discloses merely a desire to relitigate the validity of the patent by producing new models and such evidence as will convince the district court that the decision in the former case was wrong. In this connection, it is obvious we think, that the affidavit is general and, in the ordinary case, would not constitute a sufficient showing of a genuine issue as to any material fact. But, in our opinion, this is immaterial under the facts of the present case.

This suit was pending at the time of our former decisions. It was against other alleged infringers who are not shown to be identified in any wise with the defendants in the former case, or in privity with them. It would seem axiomatic therefore, that the rules of *res adjudicata* do not apply and, indeed, defendants do not insist that they do. Nor can it be said that our decision in the former case is the law of this circuit to the extent that it is decisive in other cases for infringement against other defendants. Plaintiffs have a right, if they desire, to litigate as against other defendants and not until and unless it appears by the evidence submitted at the trial that it does not differ essentially from the evidence submitted in the former case, will the decision in the first case become the law of the present one. Thus, in *Triplett* v. *Lowell*, 297 U. S. 638, at 642-644, the Supreme Court said: "Neither reason nor authority supports the contention that an adjudication adverse to • • • the claims of a patent precludes another suit upon the same claims against a different defendant. While the earlier decision may by comity be given great weight in a later litigation and thus persuade the court to render a like decree, it is not *res adjudicata* and may not be pleaded as a defense. See *Mast, Foos & Co.* v. *Stover Mfg. Co.*, 177 U. S. 485; *Sanitary Refrigerator Co.* v. *Winters*, 280 U. S. 30, 35. • • • neither the rules of the common law applicable to successive litigations concerning the same subject matter, nor the disclaimer statute, precludes relitigation of the validity of a patent claim previously held invalid in a suit against a different defendant." It continued at 648: "The fact that the suit was brought in the same circuit where the court of appeals had previously held some of the claims invalid is immaterial, for the court must decide whether the issues of law and fact in the two cases are the same, and if they are not it is not bound by the earlier decision."

A case similar to the one before us is *Gold Seal Importers, Inc.* v. *Westerman-Rosenberg, Inc.*, 133 F. 2d 192 (CA-2). There, by amended answer, the defendant averred that the patent had been held invalid by the Court of Appeals in the case of *Gold Seal Importers* v. *Morris White Fashions*, 124 F. 2d 141 (CA-2), and moved for judgment on the pleadings. There, too, the district court granted the motion merely because the validity of the patent had been decided adversely to the plaintiff in the former case. The judgment was reversed. The court said at pages 192-193: "* * * obviously that decision cannot be pleaded as *res judicata* in a suit against a different infringer not in privity with Morris White Fashions. Nor is it a precedent which the district court was bound to follow, unless the evidence pertinent to the issue of validity is the same in both cases. *Smith* v. *Hall*, 301 U. S. 216, 218, 57 S. Ct. 711, 81 L. Ed. 1049; *Lektophone Corp.* v. *Miller Bros.*, D. C. Del., 37 F. 2d 580, 581; *Minerals Separation* v. *Butte & Superior Copper Co.*, D. C. Mont., 237 F. 401, 402."

Of course it is desirable that there should be an end to litigation. But this beneficent result cannot be attained at the expense of depriving plaintiffs of the right to show, if they can, that, as against defendants who have not previously been in court, the patent is valid and infringed.

The judgment is reversed and the cause remanded to the district court for further proceedings consistent with this opinion.

SCHNACKENBERG, *Circuit Judge*, concurring. I believe that Judge Lindley has correctly applied the law, in its existing state, to the case before us. While the counter-affidavit of Aghnides is defective, I believe that it is superfluous and that he is entitled under existing law to another day in court where he may relitigate the same issue upon which he lost in the *Goodrie* case. The law does not require

him to justify this indulgence. He is entitled to it because a suit testing the validity of a patent is not a proceeding *in rem* and hence Aghnides may litigate and relitigate again and again the question of validity of his patent as long as he selects a different defendant in each of the infringement suits which he files, thus avoiding the wholesome doctrine of *res adjudicata*. This queer result is one which we are unable to avoid. It is a situation which is particularly abhorrent when considered against the backlog of untried cases which clogs our federal courts. The latter are cases where the litigant asks only for his day in court, not a plurality of days in court as Aghnides is entitled to under the existing law. The remedy lies not in our hands. The congress could by legislation grant relief.

APPENDIX D.

35 U. S. C. §102.

The pertinent portion of 35 U. S. C. §102, 66 Stat. 797 (R. S. 4886 and 4887), is as follows:

§102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

• • • • •

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

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APPENDIX D.

INTERNATIONAL PATENT CONVENTION.

The pertinent portion of the International Patent Convention, 53 Stat. 1748, is as follows:

(53 Stat. 1748)

June 2, 1934
(T. S. No. 941)

Convention between the United States of America and other powers for the protection of industrial property, revising the Paris convention of March 20, 1883, revised at Brussels on December 14, 1900, at Washington on June 2, 1911, and at The Hague on November 6, 1925. Signed at London June 2, 1934; ratification advised by the Senate June 5, 1935; ratified by the President June 27, 1935; ratification of the United States of America deposited at London July 12, 1935; proclaimed October 28, 1938.

BY THE PRESIDENT OF THE UNITED STATES OF AMERICA.

A PROCLAMATION.

Multilateral convention for the protection of industrial property. Preamble. 25 Stat. 1372; 32 Stat. 1936; 38 Stat. 1655; 47 Stat. 1789.

WHEREAS a convention revising the convention for the protection of industrial property signed at Paris on March 20, 1883, revised at Brussels on December 14, 1900, at Washington on June 2, 1911, and at The Hague on November 6, 1925, was signed by the respective plenipotentiaries of the United States of America and certain other countries at London on June 2, 1934, which convention in the French language is word for word as follows:[1]

* * * * * *

[1] NOTE. For English translation see p. 1768.

(53 Stat. 1768)

[Translation.]

CONVENTION OF UNION OF PARIS OF MARCH 20, 1883, FOR THE PROTECTION OF INDUSTRIAL PROPERTY, REVISED AT BRUSSELS DECEMBER 14, 1900, AT WASHINGTON JUNE 2, 1911, AT THE HAGUE NOVEMBER 6, 1925, AND AT LONDON JUNE 2, 1934.

Contracting powers

The President of the German Reich; the President of the Republic of Austria; His Majesty the King of the Belgians; the President of the United States of Brazil; the President of the Republic of Cuba; His Majesty the King of Denmark; the President of the Republic of Spain; the President of the United States of America; the President of the Republic of Finland; the President of the French Republic; His Majesty the King of Great Britain and Ireland and of the British Territories Beyond the Seas, Emperor of India; His Most Serene Highness the Regent of the Kingdom of Hungary; His Majesty the King of Italy; His Majesty the Emperor of Japan; His Most Serene Highness the Prince of Liechtenstein; His Majesty the Sultan of Morocco; the President of the United Mexican States; His Majesty the King of Norway; Her Majesty the Queen of the Netherlands; the President of the Polish Republic (in the name of Poland and the Free City of Danzig); the President of the Portuguese Republic; His Majesty the King of Sweden; the Federal Council of the Swiss Confederation; the President of the Czechoslovak Republic; His Highness the Bey of Tunisia; the President of the Turkish Republic; His Majesty the King of Yugoslavia,

Having deemed it expedient to make certain modifications and additions in the International Convention of March 20, 1883, for the creation of an International Union 25 Stat. 1372.

32 Stat. 1936, 38 Stat. 1645; 47 Stat. 1789.

for the Protection of Industrial Property, revised at Brussels on December 14, 1900, at Washington on June 2, 1911, and at The Hague on November 6, 1925, have appointed as their plenipotentiaries, to wit:

Plenipotentiaries

* * * * *

(53 Stat. 1772)

Who, having communicated their respective full powers, which were found to be in good and due form, have agreed upon the following provisions:

ARTICLE 1.

Union constituted.

(1) The countries to which the present convention applies constitute themselves into a Union for the Protection of Industrial Property.

Scope.

(2) The scope of the protection of industrial property shall include patents, utility models, industrial designs and models, trade marks, commercial names and indications of origin, or appellations of origin, as well as the repression of unfair competition.

* * * * *

Patents

(4) The term "patents" shall extend to the various types of industrial patents recognized by the laws of the countries of the Union, such as patents of importation, improvement patents, patents and certificates of addition, etc.

ARTICLE 2.

Mutual protection of industrial property.

(1) Nationals of each of the countries of the Union shall, in all other countries of the Union, as regards the protection of industrial property, enjoy the advantages that their respective laws now grant, or may hereafter grant, to their own nationals, without any prejudice to the rights specially provided for by the present convention.

Protection against infringement of rights.

Consequently they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the conditions and formalities imposed upon nationals.

* * * * *

(3) The provisions of the legislation of each of the countries of the Union relative to judicial and administrative proceedings and to competent authority, as well as to the choice of domicile or the appointment of an authorized agent, which may be required by the laws on industrial property are expressly reserved. Reservation.

* * * * *

ARTICLE 4.

A. (1) Any person who has duly applied for a patent, the registration of a utility model, industrial design or model, or trade mark in one of the countries of the Right of priority.

(53 Stat. 1773)

Union, or his legal representative or assignee, shall enjoy for the purposes of registration in other countries a right of priority during the periods hereinafter stated.

(2) Any filing having the value of a formal national filing by virtue of the internal law of each country of the Union or of international treaties concluded among several countries of the Union shall be recognized as giving rise to a right of priority. Formal national filing; recognition.

B. Consequently, subsequent filing in one of the other countries of the Union before the expiration of these periods shall not be invalidated through any acts accomplished in the interval, as, for instance, by another filing, by publication of the invention or the working thereof, by the sale of copies of the design or model, or by use of the trade mark, and these facts cannot give rise to any right Effect.

Third parties, etc.

of third parties or any personal possession. The rights acquired by third parties before the day of the first application on which priority is based shall be reserved by the internal legislation of each country of the Union.

Periods of priority.

C. (1) The above-mentioned periods of priority shall be 12 months for patents and utility models and 6 months for industrial designs and models and for trade marks.

(2) These periods shall start from the date of filing of the first application; the day of filing is not counted in this period.

* * * * *

Declaration of particulars required.

D. (1) Any person desiring to take advantage of the priority of a previous application must make a declaration giving particulars as to the date of such application and the country in which it was made. Each country will determine the latest date at which such declaration must be made.

Statement of particulars.

(2) The particulars referred to shall be stated in the publications issued by the competent authority, and in particular in the patents issued and the specifications relating thereto.

Production of certified copy of prior application.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (with the specification, drawings, etc.) previously made. The copy, certified as correct by the authority receiving this application, shall not require legal authentication, and in all cases it can be filed, without fee, at any time within the period of 3 months from the filing of the application. They may also require that the declaration later be accompanied by a certificate by the proper authority showing the date of application, and also by a translation.

Further formalities unnecessary.

(4) No other formalities may be required for the declaration of priority at the time application is filed. Each

of the countries of the Union shall decide upon the consequences of the omission of the formalities prescribed by this article, but such consequences shall in no case exceed the loss of the right of priority.

(5) Further proof in support of the application may be required later. **Further proof.**

(53 Stat. 1774)

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H. Priority cannot be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims made in the application in the country of origin, provided that the application, as a whole, discloses precisely the aforesaid elements. **Priority not to be refused because of absence of certain elements in application.**

ARTICLE 4 *bis*.

(1) Patents applied for in the various countries of the Union by persons entitled to the benefits of the Union shall be independent of the patents obtained for the same invention in other countries, whether or not such countries be parties to the Union. **Independence of patents applied for.**

(2) This stipulation must receive a strict interpretation; in particular, it shall be understood to mean that patents applied for during the period of priority are independent, both as regards the grounds for refusal and revocation and as regards their normal duration.

(3) This stipulation shall apply to all patents already existing at the time when it shall come into effect.

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